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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,179	11/20/2003	Micheal Talley	200309402-1	9350

22879 7590 07/29/2008
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INTELLECTUAL PROPERTY ADMINISTRATION
FORT COLLINS, CO 80527-2400

EXAMINER

PARK, CHAN S

ART UNIT	PAPER NUMBER
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2625

NOTIFICATION DATE	DELIVERY MODE
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07/29/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/718,179	Applicant(s) TALLEY ET AL.	
	Examiner CHAN S. PARK	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,6-19,24 and 25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 25 is/are allowed.
- 6) ☒ Claim(s) 1,3,4,6-19 and 24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/13/08 has been entered.

Response to Amendment

2. Applicant's amendment was received on 3/28/08, and has been entered and made of record. Currently, **claims 1, 3, 4, 6-19, 24 and 25** are pending.

Response to Arguments

3. Applicant's arguments with respect to **claims 1, 3, 4, 6-19, 24 and 25** have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

4. Claims are objected to because of the following informalities:

Claim 8, line 1, "method of claim 2" should be -- method of claim 1 --;

Claim 8, line 2, "electric edit symbol" should be -- electric edit instruction --;

Claim 9, line 1, "method of claim 2" should be -- method of claim 1 --;

Claim 10, line 2, "electric edit symbol" should be -- electric edit instruction --;

Claim 11, line 3, "scanning an entire printed document" should be -- scanning the entire printed document --;

Claim 11, line 5, "one standard handwritten edit" should be -- one standard handwritten edit symbol --; and

Claim 13, line 4, "one standard handwritten symbol" should be -- one standard handwritten edit symbol --.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The MPEP at 2173.05(i) states:

"The mere absence of a positive recitation is not basis for an exclusion. Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph, as failing to comply

with the written description requirement. Note that a lack of literal basis in the specification for a negative limitation may not be sufficient to establish a prima facie case for lack of descriptive support. Ex parte Parks, 30 USPQ2d 1234, 1236 (Bd. Pat. App. & Inter. 1993)."

Examiner does not find any support for the negative limitation, "independent of text-based word processing", claimed in claim 1 in the Specification.

Furthermore, it is noted that the multifunction printer 16 shown in fig. 2 of the current application includes OCR 66, text editor 65 and a plurality of printable files 27. If they are all independent from text-based word processor, it is unclear how text printable files can be retrieved/generated from the scanned document. The examiner notes that the scanned document must be text/word processed in order to generate text printable files. The examiner respectfully requests the applicant to specifically point out how the multifunction printer is independent of text-based word processing.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1, 11 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "a method of editing, independent and separate of a computer". It is unclear as to how this method, which is not a physical component, is

separate from a computer. Clarification/explanation from the Specification is respectfully requested.

Claims 11 and 13 recite the limitation of a multifunction printer, independent of and separate from a computer. Upon careful review of the Specification, the multifunction printer shown in fig. 1 includes the features of a computer. For example, it includes a CPU, a memory, a user interface and computer programs for editing/transmitting/emailing image data via a network. Hence, it is unclear as to how this multifunction printer can be independent of and separate from a computer. For examining purpose, the claimed multifunction printer is understood to be independent of and separate from an external computer. Please note that any computer which includes an embedded/internal printer is construed as the multifunction printer.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 3, 4, 6-16, 18 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over MacLean et al. U.S. Patent No. 7,131,061 (hereinafter MacLean) in view of Kikinis U.S. Patent No. 5,870,624.

With respect to claim 1, MacLean teaches a method of editing a printed page, comprising:

automatically scanning the printed page (col. 4, lines 38-42 & col. 7, line 8), wherein the printed page includes text and at least one standard handwritten edit symbol (col. 6, lines 21-26);

electronically obtaining a first page description file, which corresponds to at least the text on the printed page (note that the unedited document file must be obtained in order to apply the desire modification to the document in col. 7, lines 49-63);

electronically identifying from the scanned printed page at least one electronic edit instruction, which corresponds to the at least one standard handwritten edit symbol (col. 7, lines 59-63 & col. 8, lines 6-10); and

electronically and automatically modifying, independent of text-based word processing (col. 5, lines 15-21), the first page description file using the at least one electronic edit instruction to reflow the first pare description file to create a second page description file that includes the text modified according to the at least one standard handwritten edit symbol (upon accepting the physical marks/annotations, the electronic document file is edited and a newly edited document file is created in col. 8, lines 6-10).

It is well known to one of ordinary skill in the art that the system shown in figs. 1 & 4 can be connected to another computer for exchanging data via a network. Furthermore, it is well known to one of ordinary skill in the art at the time of the invention that the method of editing the printed page according to MacLean is independent and separate of a computer (that is, independent and separate from an external computer connected in the network).

MacLean, however, does not explicitly teach that the method of editing the printed page is exclusively performed via a multifunction printer.

Kikinis, the same field of endeavor of the modifying/editing the printed page, teaches a method of editing a printed page, comprising:

automatically scanning (scanning a document using the platen and roller assembly in col. 3, lines 50-65 & col. 4, lines 31-34), via a multifunction printer (figs. 1 & 2), the printed page, wherein the printed page includes text (text document in col. 11, lines 11-13);

electronically obtaining, via the multifunction printer, a first page description file (unedited ASCII-based file in col. 11, lines 13-15. Note that the ASCII-based file is construed as PCL, which is one of page description files, according to U.S. Patent No. 7,068,387 (col. 4, lines 1-2)), which corresponds to at least text on the printed page (col. 11, lines 13-15);

electronically modifying, via the multifunction printer, the first page description file using at least one electronic edit instruction to create a second page description file that includes the text modified according to the instruction (user editing the file to create a edited ASCII based file (the second page description file) in col. 11, lines 17-20).

Note that the method of Kikinis is exclusively performed via a single system 11, which is construed as a multifunction printer since it includes a printer and a scanner.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the system of MacLean to include the scanning/capturing part and editing part into a single device as taught by Kikinis.

The suggestion/motivation for doing so would have been to process the whole editing method using a single device.

Therefore, it would have been obvious to combine MacLean with Kikinis to obtain the invention as specified in claim 1.

With respect to claim 3, the Examiner takes an Official Notice that digitally sending the second page description file to a recipient via the email transmission and sending the second page description file to an external memory location using the device of Kikinis shown in fig. 1 is well known in the computer network art. Therefore, it would have been obvious to one of ordinary skill in the art to modify the device of Kikinis to transmit the edited document to external location to share the data with other recipients.

With respect to claim 4, MacLean teaches method wherein electronically obtaining the first page description file comprises: obtaining a digital image file of the printed page by scanning the printed page with a scanner of the multifunction printer and optically recognizing the digital image file, via the multifunction printer, for conversion to the first page description file (note that the unedited document file must be obtained in order to apply the desire modification to the document in col. 6, lines 21-36 & col. 7, lines 49-63).

With respect to claim 6, MacLean teaches method wherein electronically obtaining the first page description file comprises: optically recognizing, via the multifunction printer, an electronic identifier of the printed page as an electronic memory pointer and, based on the electronic memory pointer, retrieving the first page description

file from a memory of the multifunction printer or a memory available at a uniform resource locator address (col. 8, lines 27-43).

With respect to claim 7, MacLean teaches method wherein electronically obtaining the first page description file comprises: optically recognizing, via the multifunction printer, an electronic identifier of the printed page a memory and retrieving the first page description file from the memory of the electronic identifier (col. 8, lines 27-43).

With respect to claim 8, MacLean teaches method wherein electronically identifying the at least one electronic edit instruction via the multifunction printer comprises:

optically recognizing the at least one standard handwritten edit symbol as the at least one electronic instruction from a first array of electronic edit instructions stored in a memory of the multifunction printer (col. 7, lines 59-63 & col. 8, lines 6-10); and

wherein electronically and automatically modifying the first page description file comprises:

retrieving the at least one electronic edit instruction from a second edit symbol array stored in the computer; and

applying, at the computer, the at least one electronic edit instruction of the first page description file (upon accepting the physical marks/annotations, the electronic document file is edited and a newly edited document file is created in col. 8, lines 6-10).

With respect to claim 9, the combination does not explicitly teach whether the retrieval of the file is done wirelessly. Examiner take an Official Notice that the wireless communication in the network printer embedded in PC of Kikinis is well known in the network art. Therefore, it would have been obvious to one of ordinary skill in the art to implement the wireless communication function in the combined system.

With respect to claim 10, MacLean teaches method wherein electronically identifying the at least one electronic edit instruction via the multifunction printer comprises:

optically recognizing the at least one standard handwritten edit symbol as the at least one electronic instruction from a first array of electronic edit instructions stored in a memory of the multifunction printer (col. 7, lines 59-63 & col. 8, lines 6-10); and

wherein electronically and automatically modifying the first page description file comprises:

retrieving the at least one electronic edit instruction from the edit symbol array and applying, at the multifunction printer, the at least one electronic edit instruction to the first page description file (upon accepting the physical marks/annotations, the electronic document file is edited and a newly edited document file is created in col. 8, lines 6-10).

With respect to claim 11, MacLean teaches a method automatically editing a printed document, the method comprising:

scanning an entire printed document (col. 4, lines 38-42 & col. 7, line 8) with the printed document including text and at least one standard handwritten edit symbol (col. 6, lines 21-26);

electronically and automatically identifying, via the scanned printed document, the at least one standard handwritten edit symbol on the printed document (col. 4, lines 38-42 & col. 6, lines 21-26);

electronically and automatically determining at least one electronic edit instruction corresponding to the at least one standard handwritten edit symbol (col. 4, lines 38-42 & col. 6, lines 21-26);

electronically obtaining a first electronic printable file corresponding to the printed document (note that the unedited document file must be obtained in order to apply the desired modification to the document in col. 7, lines 49-63); and

electronically and automatically applying, to the first electronic printable file, the at least one electronic edit instruction to create a second electronic printable file including modified text of the printed document (upon accepting the physical marks/annotations, the electronic document file is edited and a newly edited document file is created in col. 8, lines 6-10).

It is well known to one of ordinary skill in the art that the system shown in figs. 1 & 4 can be connected to another computer for exchanging data via a network. Furthermore, it is well known to one of ordinary skill in the art at the time of the invention that the method of editing the printed page according to MacLean is independent and

separate of a computer (that is, independent and separate from an external computer connected in the network).

MacLean, however, does not explicitly teach that the method of editing the printed page is performed via a multifunction printer.

Kikinis, the same field of endeavor of the modifying/editing the printed page, teaches a method of editing a printed page, comprising:

automatically scanning (scanning a document using the platen and roller assembly in col. 3, lines 50-65 & col. 4, lines 31-34), via a multifunction printer (figs. 1 & 2), the printed page, wherein the printed page includes text (text document in col. 11, lines 11-13);

electronically obtaining, via the multifunction printer, a first page description file (unedited ASCII-based file in col. 11, lines 13-15. Note that the ASCII-based file is construed as PCL, which is one of page description files, according to U.S. Patent No. 7,068,387 (col. 4, lines 1-2)), which corresponds to at least text on the printed page (col. 11, lines 13-15);

electronically modifying, via the multifunction printer, the first page description file using at least one electronic edit instruction to create a second page description file that includes the text modified according to the instruction (user editing the file to create a edited ASCII based file (the second page description file) in col. 11, lines 17-20).

Note that the method of Kikinis is exclusively performed via a single system 11, which is construed as a multifunction printer since it includes a printer and a scanner.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the system of MacLean to include the scanning/capturing part and editing part into a single device as taught by Kikinis.

The suggestion/motivation for doing so would have been to process the whole editing method using a single device.

Therefore, it would have been obvious to combine MacLean with Kikinis to obtain the invention as specified in claim 11.

With respect to claim 12, Kikinis teaches method comprising a step of printing the second electronic printable file (printing the edited file in step 213 in fig. 9).

With respect to claim 24, the combination teaches the method of claim 11, wherein the first electronic file comprises a first page description file (note that the unedited document file must be obtained in order to apply the desire modification to the document in col. 7, lines 49-63) and wherein the second electronic printable file comprises a second page description file (upon accepting the physical marks/annotations, the electronic document file is edited and a newly edited document file is created and displayed in col. 8, lines 6-10).

With respect to claim 13, MacLean discloses a computer system comprising:
a memory;

a scanner configured for obtaining an electronic image file of at least one printed page (col. 4, lines 38-42 & col. 7, line 8) that includes a text and at least one standard

handwritten symbol and for storing the electronic image file in the memory (col. 6, lines 21-26);

an optical recognition function configured to perform an optical character recognition on the electronic image file to recognize the at least one standard handwritten edit symbol and configured to obtain a first page description file corresponding to the text of the at least one printed page (col. 4, lines 38-42 & col. 5, lines 46-60); and

an edit manager stored in the memory and configured, in communication with the optical recognition function, to automatically implement at least one electronic edit instruction corresponding to the at least one recognized standard handwritten edit symbol to the first page description file (note that the unedited document file must be obtained in order to apply the desire modification to the document in col. 7, lines 49-63) to create a second page description file that includes the text modified according to the at least one recognized standard handwritten edit symbol (upon accepting the physical marks/annotations, the electronic document file is edited and a newly edited document file is created in col. 8, lines 6-10),

wherein the edit manager implements the at least one electronic edit instruction (col. 8, lines 6-10).

It is well known to one of ordinary skill in the art that the system shown in figs. 1 & 4 can be connected to another computer for exchanging data via a network. Furthermore, it is well known to one of ordinary skill in the art at the time of the invention that the method of editing the printed page according to MacLean is independent and

separate of a computer (that is, independent and separate from an external computer connected in the network).

MacLean, however, does not explicitly teach that the method of editing the printed page is exclusively performed via a multifunction printer.

Kikinis, the same field of endeavor of the modifying/editing the printed page, teaches a method of editing a printed page, comprising:

automatically scanning (scanning a document using the platen and roller assembly in col. 3, lines 50-65 & col. 4, lines 31-34), via a multifunction printer (figs. 1 & 2), the printed page, wherein the printed page includes text (text document in col. 11, lines 11-13);

electronically obtaining, via the multifunction printer, a first page description file (unedited ASCII-based file in col. 11, lines 13-15. Note that the ASCII-based file is construed as PCL, which is one of page description files, according to U.S. Patent No. 7,068,387 (col. 4, lines 1-2)), which corresponds to at least text on the printed page (col. 11, lines 13-15);

electronically modifying, via the multifunction printer, the first page description file using at least one electronic edit instruction to create a second page description file that includes the text modified according to the instruction (user editing the file to create a edited ASCII based file (the second page description file) in col. 11, lines 17-20).

Note that the method of Kikinis is performed via a single system 11, which is construed as a multifunction printer since it includes a printer and a scanner.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the system of MacLean to include the scanning/capturing part and editing part into a single device as taught by Kikinis.

The suggestion/motivation for doing so would have been to process the whole editing method using a single device.

Therefore, it would have been obvious to combine MacLean with Kikinis to obtain the invention as specified in claim 13.

With respect to claim 14, MacLean discloses the multifunction printer wherein the OCR function is further configured to optically recognize an electronic identifier of the at least one printed page from the electronic image file for use as a memory pointer that points to an external memory location and retrieving the first page description file from that external memory location (col. 3, lines 12-23).

With respect to claim 15, arguments analogous to those presented for claim 3, are applicable.

With respect to claim 16, arguments analogous to those presented for claims 6 and 10, are applicable.

With respect to claim 18, the combination discloses the multifunction printer of claim 13 wherein the optical character recognition function is stored in at least one of the memory of the multifunction printer, a controller of the multifunction printer, and an application specific integrated circuit (col. 11, lines 12-25 of Kikinis).

8. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of MacLean and Kikinis as applied to claim 16 above, and further in view of Frank U.S. Patent No. 3,611,291.

With respect to claim 17, the combination discloses the printer of claim 16 but it does not explicitly disclose an edit rule library including a format function. Frank teaches the method of recognizing the handwritten symbol to change the format of text to Vogue Bold with a 20-point and 11-pica line (col. 4, lines 12-13). At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the system of MacLean to include the format editing function as taught by Frank. The suggestion/motivation for doing so would have been to edit/change the format of the printed text by recognizing the handwritten symbols.

9. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of MacLean and Kikinis as applied to claim 13 above, and further in view of Minami et al. U.S. Patent Application Pub. No. 2004/0141200 (hereinafter Minami).

With respect to claim 19, the combination discloses the multifunction printer of claim 13 but it does not disclose a wireless transceiver configured for communication with a wireless transponder tag of the at least one printed page with the wireless transponder tag being configured as a memory pointer that identifies a memory location storing the first page description file.

Minami, the same field of endeavor of the multifunction printer, discloses the printer (fig. 1) having a wireless transceiver configured for communication with a

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wireless transponder tag of the at least one printed page with the wireless transponder tag being configured as a memory pointer that identifies a memory location storing the first page description file (paragraphs 74 & 75).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the printer of Kikinis to include a wireless transceiver configured for communication with a wireless transponder tag of the at least one printed page with the wireless transponder tag being configured as a memory pointer that identifies a memory location storing the first page description file as taught by Minami.

The suggestion/motivation for doing so would have been to facilitate the file searching method by implementing the IC tag into the printed page.

Therefore, it would have been obvious to combine three references to obtain the invention as specified in claim 19.

Allowable Subject Matter

10. **Claim 25** is allowed.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHAN S. PARK whose telephone number is (571)272-7409. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/CHAN S PARK/
Examiner, Art Unit 2625

July 24, 2008